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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/817,646	03/26/2001	Johann Engelhardt	LASP:104_US_	8779

7590 11/01/2002  
Simpson, Simpson & Snyder, L.L.P.  
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Williamsville, NY 14221

EXAMINER

ROBINSON, MARK A

ART UNIT	PAPER NUMBER
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2872

DATE MAILED: 11/01/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/817,646

Applicant(s)

ENGELHARDT, JOHANN

Examiner

Mark A. Robinson

Art Unit

2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 29 July 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Claim Objections***

A claim which depends from a dependent claim should not be separated by any claim which does not also depend from said dependent claim. It should be kept in mind that a dependent claim may refer to any preceding independent claim. See MPEP § 608.01(n). Applicant is reminded of the proper sequencing of claims as set forth above, as the order of claims of the instant application as currently presented is difficult to follow.

1. Claims 15, 23 and 27 are objected to because of the following informalities:

In claim 15 "the intra-laser point light source" lacks antecedent basis.

In claims 23 and 27 "the illumination stop" lacks antecedent basis.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

1. Claims 9, 29 and 31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point

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out and distinctly claim the subject matter which applicant regards as the invention.

In claim 9 both the light source and the detection stop are said to be in "corresponding" planes. This language seems to imply that these elements are located in the same position, contrary to the teachings of the disclosure. Thus, the relative arrangement of these elements is unclear.

In claim 29 "the reference planes" lacks antecedent basis and it is unclear what this phrase references.

Claim 31 recites a method but depends from apparatus claim 30. Thus, it is unclear what is intended to be covered by this claim.

Inasmuch as these claims are able to be understood in light of the 112 rejections made above, the following rejection(s) directed thereto apply:

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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3. Claims 1-6,9,11-13,18-21 and 28-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Ellis et al.

Ellis shows a method and apparatus for aligning the optical beam path of a microscope, including an illumination stop(53) and detection stop(65), by providing the center of the detection stop as a first reference point and providing a second reference point (such as an objective pupil). Note that this only requires the system to include a detection aperture and another selected "reference point," with a beam path being defined between any two such points. Further, note that when the system's elements are aligned for operation, they will be aligned or alignable with respect to the reference points.

*Claim Rejections - 35 USC § 103*

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 7,8,10,14-17 and 22-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis et al.

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Regarding claim 7, although not disclosed by Ellis, iterative alignment methods are well known in the art. Such an alignment method would have been obvious to the ordinarily skilled artisan at the time of invention in order to arrange the system elements for proper operation.

Regarding claims 8,10 and 22-27, although not taught specifically by Ellis, movement of the light source and/or aperture via lateral shifting or rotation is known in the prior art. It would have been obvious at the time of invention to move the light source in such a manner when initially aligning the system's elements to enable proper functioning of the microscope.

Regarding claims 14-17, Ellis does not teach the types of light sources found in these claims. However, each is a well known type of microscope illumination and would have been obvious to the ordinarily skilled artisan at the time of invention as an obvious functional equivalent of the light source shown by Ellis.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The references

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to Reffner et al, Baer, and Bewersdorf et al all show microscope systems with illumination and/or detection apertures.

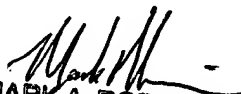
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Robinson whose telephone number is (703) 305-3506.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cassandra Spyrou can be reached at (703) 308-1687. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-7722.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

MR

10/29/02

  
MARK A. ROBINSON  
PRIMARY EXAMINER